

In this response, Applicants respectfully request reconsideration and withdrawal of the objection and rejections outlined in the Advisory Action.

In this response, Applicants also submit a Supplemental Information Disclosure Statement.

SECTION 112 OBJECTION AND REJECTIONS

A. The Examiner has objected to the specification and rejected Claims 1-2, stating that there is a lack of support for the inclusion in the claims of the terms "benzyloxy" and "benzyl-S-" and any terms containing these terms.

Applicants assert that the inclusion of these terms in Claims 1 and 2 by amendment is fully supported by the specification. In particular, the Examiner is directed to the definition of terms "alkoxy" and "thioalkoxy" which are found on page 13 of the specification. The definition states, "The terms "alkoxy" and "thioalkoxy" as used herein refer to $R_{15}O-$ and $R_{15}S-$, respectively, wherein R_{15} is a loweralkyl group or benzyl." Therefore, Claims 1 and 2 have been amended where the terms alkoxy and thioalkoxy occur to include benzyloxy and benzyl-S-, respectively.

B. The Examiner has rejected Claims 1, 2, 8-10, 12, 15 and 32 under 35 U.S.C. 112 (first and second paragraphs) for the use of the terms "esters and prodrugs thereof". The Examiner asserts that such compounds are not enabled. Applicants assert that all such compounds are fully enabled by the specification and that such compounds have the disclosed utility. However, in an effort to advance the prosecution of this application (but without acquiescing to the rejection), Applicants have amended the claims herein to delete the terms "esters and prodrugs thereof". Applicants reserve the right to file a divisional application claiming the subject matter cancelled by this amendment.

C. Lastly, the Examiner has rejected the method claims (i.e., Claims 12 and 15) under 35 U.S.C. 112. The Examiner states that the date of the reference provided by Applicants in support of the patentability of these claims is not good.

Applicants assert that from the time of its filing this application has disclosed the utility of the compounds of the invention for inhibiting HIV protease and for inhibiting an HIV infection in humans. The reference provided to the Examiner on March 2, 1995 in response to the final rejection of the parent application to this File Wrapper Continuation application (i.e., Ho, et al., Nature, Vol. 373, pages 123-126 (1995)) merely provides corroboration of the utility that has been disclosed and claimed from the date of filing of this application. Therefore, Applicants respectfully assert that the Examiner should accept the reference as supporting the patentability of use Claims 12 and 15 and the Examiner should find Claims 12 and 15 allowable.

In view of the above, the Examiner is respectfully requested to reconsider and withdraw the Section 112 objection and rejections.

OBJECTION TO CLAIMS 3-7 and 18-20

The Examiner has objected to Claims 3-7 and 18-20 as being dependent upon a rejected base claim. Applicants assert that in view of the amendments to the claims submitted herein, the base claims are now allowable. Therefore, the Examiner is respectfully requested to reconsider and withdraw the objection to Claims 3-7 and 18-20.

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

The following information is submitted pursuant to 37 C.F.R. 1.97 and 1.98 in accordance with Applicants' duty of disclosure under 37 C.F.R. 1.56. This submission is not an admission that the documents cited herein are prior art as to the invention claimed.

The following reference is known to the Applicants:

1. Kempf, et al., U.S. Patent No. 5,354,866, issued October 11, 1994.

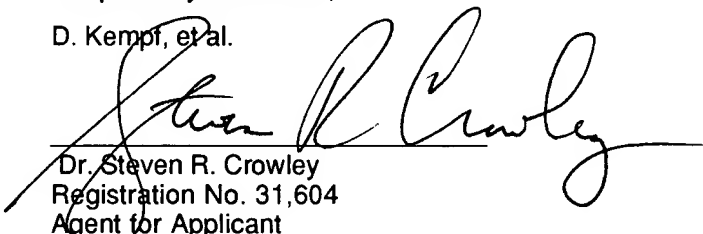
A copy of this reference is enclosed. Applicants respectfully request that this reference be made of record.

ACTION REQUESTED

In view of all of the above, reconsideration and allowance of Claims 1-7, 9-10, 12, 15, 18-19, 29 and 30-32 (as amended) and entry of the cited reference on the record are respectfully requested.

Respectfully submitted,

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